



UNITED STATES PATENT AND TRADEMARK OFFICE

cl

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/724,223	12/01/2003	Jon Elliot Adler	54072D2	9750

21967 7590 04/18/2007

HUNTON & WILLIAMS LLP
INTELLECTUAL PROPERTY DEPARTMENT
1900 K STREET, N.W.
SUITE 1200
WASHINGTON, DC 20006-1109

EXAMINER

BRANNOCK, MICHAEL T

ART UNIT	PAPER NUMBER
----------	--------------

1649

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/18/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/724,223

Applicant(s)

ADLER

Examiner

Michael Brannock

Art Unit

1649

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 287-338 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 287-338 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Status of Application: Claims and Amendments

Applicant is notified that the amendments put forth on 1/11/2007, have been entered in full. Claims 1-286 have been canceled. New claims 287-338 are currently under examination.

Response to Amendment

Applicant is notified that any outstanding objection or rejection that is not expressly maintained in this Office action has been withdrawn in view of Applicant's amendments and upon further consideration of the word "putatively" as it is used in the claims, i.e. see page 2 of the prior Office action.

Claim Objections

Claim 287 is objected to because of the following informalities: there is a period in line one. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 272-308 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, for the following reasons.

Art Unit: 1649

Claims 287-297 require a polypeptide “contained in” SEQ ID NO: 17 it is unclear what limitations the phrase “contained in” places on the claims. It is suggested that the claim read “polypeptide of SEQ ID NO: 17”.

Claims 208 and 320 require that the polypeptide is expressed by a cell. As a polypeptide can be expressed by a cell and then purified or, alternatively, expressed by the cell and used without purification, it is unclear what the claims are intended to encompass.

Claim 293 requires a T1R1 polypeptide that is 97% identical to a polypeptide of SEQ ID NO: 21, yet there appears to be only 20 sequences listed in the specification. Appropriate clarification or correction is required.

Claim 336 requires “said putative taste modulator”, yet this phrase lacks antecedent basis; thus the artisan would not know which putative taste modulator is said putative taste modulator.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 287-338 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention, for the following reasons.

The claims are directed to methods for identifying a compound that putatively modulates or elicits taste in a human subject, specifically with regard to a polypeptide of SEQ ID NO: 17

Art Unit: 1649

which is termed hT1R1. The specification asserts it is believed that T1R protein family members are components of the taste transduction pathway and may be involved in taste detection of sweet substances and/or other taste modalities and particularly that T1R1 and T1R2 may physically interact or, alternatively, that they may act independently, see page 9. It is generally agreed in the art that only T1R3 is capable of acting a taste receptor alone, see page 192, col 1, of Temussi-P et al., J. Mol. Recognition 19(188-199)2006. Thus, the claims are not directed to a functional taste receptor. Additionally, the claims require a compound that specifically binds to the polypeptide of SEQ ID NO: 17, yet no such compounds have been taught in the specification. As set forth previously, Hoon *et al.*, *Cell* 96(541-551)1999, report that “We have attempted to determine the ligand/tastant specificity of TR1 and TR2 using a variety of strategies but have been hampered by the difficulty of functionally expressing these molecules in heterologous system see col 1 of page 547”. The art regarding T1R receptors, as exemplified by Hoon et al., recognizes the complexity, unpredictability, and non-routine nature of the work involved in trying to assay functional T1R receptors and their ligands. The specification has not taught what compounds are to be used in the claimed method.

Applicant argues, essentially, that one skilled in the art could find such ligands, because by default the artisan would know to look to sweet or umami ligands. This argument has been fully considered but not deemed persuasive, for the reasons provided above.

Claims 287-380 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant

Art Unit: 1649

art that the inventor(s), at the time the application was filed, had possession of the claimed invention. As set forth above, the claims require embodiments wherein the identified compound modulate the specific binding of another compound that specifically binds to the polypeptide of SEQ ID NO: 17, yet no such specific binding compounds have been taught in the specification. The specification has not taught where to obtain such and it does not assert that any particular compound would have this property. Thus the one skilled in art would not recognize that Applicant was in possession of such compounds that are needed to practice the claimed methods. Applicant argues, essentially, at pages 10-12 of the 1/11/2007 that one skilled in the art could find such ligands, e.g. by using artificial and natural sweet and savory compounds. This argument has been fully considered but not deemed persuasive; the specification does not teach what type of compounds bind to T1R1.

Claim 338 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 338 is additionally rejected under 35 U.S.C. 112, first paragraph, because it constitutes new matter. There is no assertion in the specification that T1R1- binding compounds are have an effect on sweet or ummi taste.

Art Unit: 1649

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Brannock, Ph.D., whose telephone number is (571) 272-0869. The examiner can normally be reached on Mondays through Fridays from 10:00 a.m. to 4:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres, Ph.D., can be reached at (571) 272-0867. Official papers filed by fax should be directed to **571-273-8300**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

MB


4/15/2007


JANET L. ANDRES
SUPERVISORY PATENT EXAMINER